

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-4, 6, 8-15, 17-19 and 38 are pending in the application, with claims 1, 11 and 38 being the independent claims.

Claims 5, 20-22 and 25-36 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. No new claims are sought to be added. Claims 1-3 and 6 are amended herein. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn. Applicants believe that the amendments and remarks herein address each of the Examiner's rejection and make the claims allowable, or at least render the claims in better condition for appeal.

Rejections under 35 U.S.C. § 102

The Examiner rejected claims 1, 2 and 8 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,621,648 to Ivany. Applicants respectfully traverse this rejection. Claim 1 recites that "a portion of said upper is formed of a material having a first side and a second wherein said first side has a pile and said second side has hooks opposite substantially everywhere said first side has pile." The Ivany reference teaches an ankle support system that includes, a conventional shoe, an ankle brace that is worn by the user in a manner similar to a sock and inserted into a conventional shoe, and straps that are

"attached to the user's shoe." Ivany, col. 2, line 24. The shoe appears to be a conventional shoe, which includes a conventional upper. No portion of the conventional upper utilizes either hook or pile. The straps attached thereto are distinguished from the upper of the shoe because "the straps are connected to a user's shoe 26 by, for example, being stitched thereto." Ivany, col. 4, lines 32-34 (emphasis added). The Ivany reference further distinguishes the straps from the upper of the conventional shoe 26 by identifying that the strap is attached to the "shoe wall 106." Ivany, col. 4, lines 44 and 45. The purpose of the present invention is to provide a portion of said upper that is comprised of a material having hooks on one side and pile on the other to avoid having a separate piece (such as the strap of Ivany) attached, or particularly sewn, thereto. The conventional shoe described in Ivany does not have any portion thereof that includes either hook or eye material, nor does the reference suggest anything other than a separate strap being attached to the conventional shoe.

Further, claim 1 has been amended to include that the portion of the upper with hook on one side and pile on the other is at least located in a throat region of said upper. The throat region of the conventional shoe of Ivany does not contain any hook or pile pieces, but instead includes only conventional eyelets embedded in a reinforcing strip around the throat of a conventional shoe. See Ivany, Figure 6. As such, the Ivany reference does not teach each and every feature of the claimed invention.

Claims 2 and 8 depend from and add features to claim 1 and thus are patentable for the same reasons as claim 1.

In light of this amendment and the remarks above, Applicants respectfully request the withdrawal of this 35 U.S.C. § 102 rejection.

Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 1-5, 10-14, 19, 20 and 38 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 4,486,965 to Friton in view of U.S. Patent No. 5,744,080 to Kennedy. Claims 1-3, 5, 6, 10-12, 14, 15, 19 and 20 have been rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 4,114,297 to Famolare, Jr. in view of the Kennedy reference. Claims 1-5, 8, 11-14, 17, 19, 20 and 38 have been rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 4,969,277 to Williams in view of the Kennedy reference. Claims 9 and 18 have been rejected under 35 U.S.C. § 103(a) as being obvious over the Williams and Kennedy references and further in view of U.S. Patent No. 5,176,624 to Kuehnreich. According to the Examiner, it would be obvious to combine each of these references with the material taught by Kennedy to provide the hook and loop fastening materials. Applicants respectfully traverse these rejections.

Applicants submit that it would not be obvious to combine any of these references, as suggested by the Examiner. In particular, none of the Friton, Famolare, Jr., Williams, and Kuehnreich references teach any portion of the shoe upper with pile on one side and hooks on the other side opposite everywhere there is pile, which is the basis of the material disclosed in Kennedy.

For example, the Friton reference has hook material positioned in one location 134 at the end of medial and lateral straps and pile material attached in separate locations 138 and 139 at the base portion (or reinforcing strip). One would not be motivated to use the Kennedy material in the shoe disclosed by Friton because pile material on the back of the strap at location 134 and hook material on the back of the upper in locations 138 and

139 would have no utility as these sides of the material would not attach to anything.

Since the fastening system of Friton is not designed to use the opposite side of the material in these locations, it would be fruitless and unnecessary to use the material taught by Kennedy in the locations disclosed by Friton.

Further, it would be far easier to attach strips of either hook or pile material in the positions shown in Figures 8 and 9 than to form the upper with the Kennedy material embedded within the pieces of leather or other upper material. In order to use the Kennedy material in the areas suggested by Friton, one would have to cut holes in the leather or other material used for the reinforcing strip and straps in four different places, i.e., at the end of both the medial and lateral straps (position 134 in Figure 8 of Friton) and at the medial and lateral base portions 139 and 138. Then, one would have to stitch within these holes the material having one side with hook and the other side with pile. Consequently, the manufacture of the shoe would be more costly and take longer. For at least these reasons, pending claims 1-4, 10-14, 19 and 38 are patentable over the combination of the Friton and Kennedy references.

The Famolare, Jr. reference has hook material positioned in one location 18 at the end of a strap and pile material attached to the side of an upper at a location 20. One would not be motivated to use the Kennedy material in the shoe disclosed by Famolare, Jr. because pile material on the back of the strap at location 18 and hook material on the back of the upper in location 20 would have no utility, as these sides of the Kennedy material would not attach to anything. Since the fastening system of Famolare, Jr. is not designed to use the opposite side of the material in these locations, it would be fruitless

and unnecessary to use the material taught by Kennedy in the locations disclosed by Famolare, Jr.

Further, it would be far easier to attach strips of either hook or pile material in the positions shown in Figure 1 of Famolare, Jr. than to form the upper with the material embedded within the pieces of leather or other upper material. In order to use the Kennedy material in the areas suggested by Famolare, Jr., one would have to cut holes in the leather or other upper material and on the strap. Then, one would have to stitch within these holes the material having one side with hook and the other side with pile. Using this approach would make the manufacture of the shoe more costly and take longer. For at least these reasons, pending claims 1-3, 6, 10-12, 14, 15 and 19 are patentable over the combination of the Famolare, Jr. and Kennedy references.

The Williams reference has hook material positioned in two locations, on the lateral side in a toe region at location 71 and on the medial side at a heel area location 63. However, the pile material is attached in separate locations 69 and 61, at the medial side of the toe region and at the lateral side of the heel, respectively. One would not be motivated to use the Kennedy material in the shoe disclosed by Williams because the pile material on the back of the locations 71 and 63 where the hook is attached and hook material on the back of the locations 69 and 61 would serve no purpose, as these sides of the Kennedy material would not attach to anything. Since the fastening system of Williams is not designed to use the material having a hook on one side opposite every there is pile on the other side in the locations that hook and pile are used individually, it would be fruitless and unnecessary to use the material taught by Kennedy in these locations instead.

Further, it would be far easier to attach strips of either hook or pile material in the positions shown in Figure 5 of the Williams reference than to form the upper with the material embedded within the pieces of leather or other upper material. In order to use the Kennedy material in the areas suggested by Williams, one would have to cut holes in the leather or other upper material in four different places, at the medial and lateral toe region (locations 69 and 71) and at the medial and lateral heel locations 61 and 63. Then, one would have to stitch within these holes the material having one side with hook and the other side with pile. Thus, the manufacture of the shoe would be more costly and take longer. For at least these reasons, pending claims 1-4, 8, 11-14, 17 and 19 are patentable over the combination of the Williams and Kennedy references.

The Kuehnreich reference has hook material positioned in three locations, two on the forefoot region at locations 8 and 9 and one at a heel area location 12. However, it is not clear from the specification whether the pile material is attached to a separate upper 3 only at "fasteners 8,9" or whether the entire upper material is made from pile material. Nonetheless, the Kuehnreich reference does not teach a single place on the upper which has pile on a first side and hooks on a second side everywhere where the first side has pile. One would not be motivated to use the Kennedy material in the shoe disclosed by Kuehnreich because pile material on the back of the locations 8, 9 and 12 where the hook is attached and hook material on the back of locations where there is pile would serve no purpose, as these sides of the Kennedy material would not attach to anything. Since the fastening system of Kuehnreich is not designed to use the material having a hook on one side opposite everywhere there is pile on the other side in the locations that hook and pile are use individually, it would be fruitless and unnecessary to use the material taught by

Kennedy in these locations instead. For at least these reasons, pending claims 9 and 18 are patentable over the combination of the Williams, Kuehnreich and Kennedy references. Further, claims 9 and 18 depend from and add features to claims 1 and 11, respectively, and are thus patentable for the same reasons as claims 1 and 11.

Claim 20 was rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,015,251 to Cherubini in view of the Kennedy reference. Applicants have cancelled claim 20, thus rendering this rejection moot.

Claims 10, 20 and 38 have been rejected under 35 U.S.C. § 103(a) as being obvious over the Ivany reference in view of the Kennedy reference. Claim 20 has been cancelled herein. Claims 38 recites that "a portion of said upper is formed of a material having a first side and a second side wherein said first side of said material includes a plurality of hooks and said second side of said material includes a pile." As discussed above with respect to claim 1, the Ivany reference teaches the use of a conventional shoe and straps that are "attached to the user's shoe." Ivany, col. 2, line 24. No portion of the conventional shoe utilizes either hook or pile. The straps attached thereto are not considered part of the upper, or even part of the shoe, because "the straps are connected to a user's shoe 26 by, for example, being stitched thereto." Ivany, col. 4, lines 32-34 (emphasis added). The conventional shoe described in Ivany does not have any portion thereof that includes either hook or eye material, nor does the reference suggest anything other than a separate strap being attached to the conventional shoe.

Even if the straps are considered part of the shoe upper, which the Ivany reference expressly teaches agianst, claim 38 requires that hook and pile material are

coextensive, meaning that everywhere there is hook there is pile opposite, and vice versa.

As such, the Ivany patent teaches that:

If a kit is provided for two straps per shoe and if velcro is to be used as the fastener, one in each pair would have male velcro on the inside, and female velcro on the outside, while the other would have only male velcro on the inside. If there are to be more than two straps per shoe, all but one would have male velcro on the inside and female velcro on the outside, while only one would have only male velcro on the inside only.

Ivany, col. 5, lines 10-18.

Therefore, the Ivany patent does not teach that hook and pile material are coextensive. Further, the Ivany specification teaches that "the bulk may be further reduced by isolating the material to those areas where, when the straps are in position, male and female connector materials will be correspondingly juxtaposed to each other." Ivany, col. 6, lines 50-54. Thus, there would be no motivation to combine the Kennedy reference, with its coextensive material, with the Ivany reference because the Ivany reference teaches away from this sort of combination because of the added bulk.

Claim 10 is dependent from and adds features to claim 1. As such claim 10 is patentable for the same reasons as claim 1.

Other Matters

Applicants respectfully submit that claims 1-4, 6, 8-15 and 17-19 are generic to all sub-species (A-D) defined by the Examiner in the Election Requirement dated May 22, 2002. Thus, upon allowance of one or more of these generic claims, Applicants

respectfully request consideration of these claims as directed to the non-elected species and sub-species. Applicants assert the right to claim additional species in the event that a generic claim thereto is found to be allowable in accordance with 37 C.F.R. § 1.141(a).

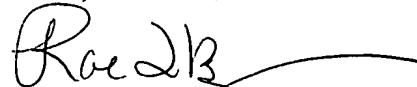
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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